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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) 102.0010-01000	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 08/480,461		Filed June 7, 1995
	First Named Inventor Gary K. Michelson		
	Art Unit 3772	Examiner Michael A. Brown	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 37,129 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
		 Signature Amedeo F. Ferraro Typed or printed name 310-286-9800 Telephone number July 26, 2007 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
<input checked="" type="checkbox"/> *Total of 1 forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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RESPONSE UNDER 37 C.F.R. 1.116  
EXPEDITED PROCEDURE  
EXAMINING GROUP 3772

PATENT  
Attorney Docket No. 102.0010-01000  
Customer No. 22882

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Gary K. Michelson ) Confirmation No.: 9274  
Serial No.: 08/480,461 )  
Filed: June 7, 1995 ) Group Art Unit: 3772  
For: INSTRUMENTATION FOR THE )  
SURGICAL CORRECTION OF HUMAN ) Examiner: Michael A. Brown  
THORACIC AND LUMBAR SPINAL )  
DISEASE FROM THE LATERAL )  
ASPECT OF THE SPINE )

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Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In reply to the Office Action of June 27, 2007, Applicant submits the following remarks for consideration by the Members of the Pre-Appeal Brief Conference.

**I. Brief Background**

The application includes claims 95-139 and 141-241 (claims 90 and 140 were previously withdrawn) of which claims 95, 102, 108, 114, 115, 131, 138, 139, and 237 are independent. Claims 95-139 and 141-241 stand rejected based on undue multiplicity under 35 U.S.C. § 112, second paragraph. This rejection is the subject of this Request for a Pre-Appeal Conference. The first office action in the present application was mailed May 26, 1998. After the substantive examination of the present application for over 8 years, in which all pending claims (except for dependent claim 241) have been substantively examined at least twice and a substantial number of claims have been allowed, the Examiner in response to the reversal of all prior art rejections by a Pre-Appeal Conference Panel, for the first time rejected claims 95-139 and 141-241 based on undue multiplicity.

**II. Clear Errors**

(1) The undue multiplicity rejection of claims 95-139 and 141-241 is erroneous at least for the following reasons:

(a) the Examiner indicates that "where, in view of the nature and scope of applicant's invention, applicant presents an unreasonable number of claims which are repetitious and multiplied, the net result of which is to confuse rather than to clarify, a rejection on undue multiplicity...may be appropriate";

(b) contrary to the Examiner's contention, Applicant submits that the prosecution history of the present application shows that the Examiner substantively examined all

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pending claims (except for dependent claim 241) at least twice, and that, in the absence of any valid art rejection of the pending claims, a Notice of Allowance is merited;<sup>1</sup>

(c) evidencing the previous substantive examination of the claims, a majority of the independent claims and claims dependent therefrom were previously allowed:

(i) independent claims 114, 115, 131, 138, and 237 were previously allowed;<sup>2</sup>

(ii) claims 141-180 and 238-240 depending from independent claims 114, 115, 131, 138, or 237, or claims dependent therefrom, were previously allowed, and claims 181-208 depending from independent claim 131, or claims dependent therefrom, are allowable at least due to their dependency from an allowed independent claim;<sup>3</sup>

(d) since the Office Action of December 27, 2005 (containing the Examiner's last prior art rejections), Applicant made no changes to the claims, and any outstanding prior art rejections of the claims were resolved in Applicant's favor:

(i) in response to the Office Action of December 27, 2005, Applicant utilized the Pre-Appeal Conference procedure and prevailed in having the Examiner's remaining prior art rejections of the claims withdrawn, and, therefore, independent claims 95, 102, 108, and 139, and claims 96-101, 103-107, 109-113, 116-130, 132-137, 209-236, and 241<sup>4</sup> depending from independent claims 95, 102, 108, or 139, or claims dependent therefrom, also appear to be in condition for allowance;<sup>5</sup>

(ii) in response to the withdrawal of the remaining prior art rejections by the Pre-Appeal Conference Panel, the Examiner after over 8 years of prosecution resorted to the undue multiplicity rejection that is the subject of this Request for a Pre-Appeal Conference;

(e) as shown in Table 1 attached hereto, a substantial number of dependent claims are directed to subject matter already examined and determined to be allowable<sup>6</sup>:

- 1 Applicant's Reply to the Office Action dated January 24, 2007 details the prosecution history of the present application, incorporated by reference herein.
- 2 Office Action dated December 27, 2005.
- 3 Office Action dated December 27, 2005.
- 4 Applicant's Reply to Office Action of March 30, 2007 inadvertently indicates that dependent claim 241 depends from independent claim 237, and should have indicated that claim 241 depends from independent claim 139.
- 5 See Notice of Panel Decision from Pre-Appeal Brief Review of November 7, 2006.
- 6 Table 1 shows the status of the allowed claims with corresponding analogs prior to the Pre-Appeal Conference based on the Office Action dated December 27, 2007. The columns correspond to independent claims 95, 102, 108, 114, 115, 131, 138, 139, and 237, and the rows include a listing of selected claims depending from each of the independent claims or claims dependent therefrom, where dependent claims in the same row are directed to the same subject matter, and the rows and columns for the allowed claims are shaded in grey.

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(i) for all but seven<sup>7</sup> of the remaining rejected dependent claims (claims 97, 99, 100, 101, 103, 236, and 241 do not have corresponding analogs), the subject matter of the rejected dependent claims, as shown in Table 1, corresponds to the subject matter of dependent claims 181-207 which depend from allowed independent claim 131 and dependent claims 143, 152, and 153 which depend from allowed independent claim 114;<sup>8</sup>

(ii) regarding the un-shaded dependent claims included in Table 1, since the Examiner has already examined the subject matter of these claims and determined it is allowable, Applicant submits that no additional burden is being placed on the Examiner;<sup>9</sup>

(f) the Examiner's previous substantive examination of the claims directly resulted in the number of independent claims being increased, because, in response to the Examiner's indication of allowable subject matter, Applicant rewrote several dependent claims in independent form (specifically, independent claims 102, 114, 115, 131, and 138), therefore, the Examiner should be precluded from now arguing that the number of claims presented is unreasonable;

(g) the Patent Office has indicated that decisions such as In re Flint<sup>10</sup> and In re Wakefield<sup>11</sup> have "severely cut back" on the application of undue multiplicity rejections;<sup>12</sup>

(i) In re Wakefield indicates that a finding in support of an undue multiplicity rejection that the number of claims is so large as to obscure the invention can be weakened by the Examiner's previous substantive examination of the claims; and, therefore, because in the present application all of the pending claims (except for dependent claim 241) have previously been substantively examined at least twice, Applicant submits that the effort expended during prosecution of the present application should preclude an undue multiplicity rejection;

7 Page 7 of Applicant's Reply to Office Action of March 30, 2007 should have indicated that "for all but seven [rather than one]" of the remaining rejected dependent claims..."

8, 9 In Table 1, independent claims 114, 115, 131, 138, and 237, and claims 141-180 and 237-240 depending therefrom, or claims dependent therefrom, were allowed by the Examiner, and claims 181-208 depending from independent claim 131, or claims dependent therefrom, are allowable at least due to their dependency from an allowable independent claim. Dependent claims 97, 99, 100, 101, 103, 236, and 241 are not included in Table 1 because these dependent claims do not have corresponding analogs. Furthermore, dependent claims 104, 105, 107, and 134 were not included in Table 1 because the Examiner indicated that these claims included allowable subject matter.

10 411 F.2d 1353, 162 U.S.P.Q. 228 (CCPA 1969).

11 422 F.2d 897, 164 U.S.P.Q. 638 (CCPA 1970).

12 See Changes to Implement Business Goals, Part II, October 5, 1998, Fed. Reg. Vol. 63, No. 192.

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(h) although the Examiner relied on In re Chandler<sup>13</sup> in support of the undue multiplicity rejection, the Patent Office has indicated in subsequent decisions that "the CCPA has declined to hold that the presentation of any particular number of claims is so excessive as to confuse or obscure the inventions defined by the claims;"<sup>14</sup>

(i) for example, Ex parte Birnbaum<sup>15</sup> indicates that "the mere psychological reaction to this amount of material [forty (40) pages of claims in Ex parte Birnbaum] does not, in and of itself, constitute a legal basis for rejection;"

(i) furthermore, decisions following In re Chandler require a showing by an Examiner in support of an undue multiplicity rejection that "the claims are so unduly multiplied that they are difficult to understand, making examination impossible, or that the claims are for the most part duplicates,"<sup>16</sup> and, because the Examiner has not made a showing of how the claims are unduly multiplied, the multiplicity rejection is improper;

(j) consequently, the status of the pending claims, in addition to the effort expended in the previous substantive examinations thereof, is contrary to the Examiner's contention that Applicant presents an unreasonable number of claims, which are repetitious and multiplied, the net result of which is to confuse rather than to clarify; and

(k) accordingly, the undue multiplicity rejection under 35 U.S.C. § 112, second paragraph, is improper and should be withdrawn.

### III. Conclusion

Reconsideration the outstanding rejection is required in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

Respectfully submitted,  
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Dated: July 26, 2007

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<sup>13</sup> 319 F.2d 211, 138 U.S.P.Q. 138 (CCPA 1963).  
<sup>14</sup> See USPTO Changes to Implement Business Goals.  
<sup>15</sup> 161 U.S.P.Q. 635, at 637 (BPAI 1968).  
<sup>16</sup> Id.

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TABLE 1

STATUS OF ALLOWED DEPENDENT CLAIMS WITH CORRESPONDING ANALOGS PRIOR TO PRE-APPEAL BRIEF CONFERENCE BASED ON OFFICE ACTION DATED DECEMBER 27, 2005									
Independent	Claim 95	Claim 102	Claim 108	Claim 114 ALLOWED	Claim 115 ALLOWED	Claim 131 ALLOWED	Claim 138 ALLOWED	Claim 139	Claim 237 ALLOWED
Dependent	96		129	151	171	201		228	
		106	133	155	175	203		230	
	98		136	158	178	206		233	
			109	141	161	181		209	
			110	142	162	182		210	
			111			183		211	
			112			184		212	
			113			185		213	
			116	145	165	188		216	
			117	146	166	189		217	
			118			190		218	
			119			191		219	
			120			192		220	
			121			193		221	
			122			194		222	
			123			195		223	
			124			196		224	
			125	147	167	197		225	
			126	148	168	198		226	
			127	149	169	199		227	
			128	150	170	200			
			130	152	172				
			132	154	174	202		229	
			135	157	177	205		232	
			137	159	179	207		234	
				143	164				
				153	173				
				156	176	204		231	
				160	180	208		235	
						186		214	
						187		215	
									238
									239
									240